



30 September 2019

Enlarged Board of Appeal  
European Patent Office  
80298 Munich  
Germany  
Attn. Mr Wiek Crasborn, registry  
[EBAamicuscuriae@epo.org](mailto:EBAamicuscuriae@epo.org)

Dear Sirs,

## Re: Amicus Curiae Brief on questions referred to the Enlarged Board of Appeal in case G3/19

We are writing to provide Intellectual Property Owners Association (IPO)'s view on the question referred to the Enlarged Board of Appeal in G3/19. IPO is pleased to be able to provide comments.

IPO is an international trade association representing companies and individuals in all industries and fields of technology that own or are interested in intellectual property rights. IPO currently represents 175 corporations and 280 law firms with more than 12,000 individuals who are involved in the association either through their companies or as inventor, author, executive, or attorney members.

The members of the IPO Boards of Directors, which approved the filing of this brief, are listed in an appendix to this letter. IPO procedures require approval of positions in briefs by a two-thirds majority of directors present and voting.

## Legal Summary and Background

Following decision T 1063/18 of 5 December 2018, the EPO President referred a question to the Enlarged Board of Appeal according to Art 112 1 (b) EPC. Questions have been raised about the admissibility of that referral because it involves different decisions given by two different Boards of Appeal on a single question. As the referral itself indicated, how to resolve the situation is not so clear. Given the importance of the issue, IPO would suggest that the Enlarged Board of Appeal take the case, or if it sees admissibility problems, provide guidance as it did in G 3/08. IPO agrees with the EPO President's statement, citing G1/97 and G 2/02, that the Enlarged Board of Appeal should use this referral as a possibility to "fill lacunae in the law, in particular where situations arise for which the legislator has omitted to provide."

## Summary of answers to questions:

IPO respectfully suggests that the questions referred to the Enlarged Board of Appeal be answered as follows:

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1. *Having regard to Article 164(2) EPC, can the meaning and scope of Article 53 EPC be clarified in the Implementing Regulations to the EPC without this clarification being a priori limited by the interpretation of said Article given in an earlier decision of the Boards of Appeal or the Enlarged Board of Appeal?*

**Suggested Answer:**

*The meaning and scope of Article 53 EPC—and subsequently any other article of the EPC—can only be clarified in the Implementing Regulations to the EPC as long as it is not a violation of an interpretation of said Article given in earlier decisions of the Enlarged Board of Appeal.*

*The meaning and scope of Article 53 EPC—and subsequently any other article of the EPC—can be clarified in the Implementing Regulations to the EPC regardless of interpretations of said Article given in earlier decisions of the Board of Appeal.*

The first question should be generalized. IPO is aware of the genesis of Art 53 EPC, and especially Rules 26 to 34 of the Implementing Regulations and the associated political situation. Nevertheless, Article 53 as such does not differ from any other article of the EPC as do Rules 26 to 34.

Therefore question 1 should be answered for Articles and Rules *per se*.

The question concerning the hierarchy of Rules of the Implementing Regulations and jurisdiction of the different bodies of the European Patent Office are not clearly codified in the European Patent Convention, nor the *travaux préparatoires*.

When looking at the caselaw, very few decisions have dealt with the relation between the legal text building up the European Patent Systems and the EPO's jurisdiction.

In its decision G2/08, the Enlarged Board of Appeal stated that its previous decisions (here the very first decision of the Enlarged Board, the *Swiss-Type* decision G1/83) may become obsolete when the applicable articles of the EPC are changed. Thus, a change in the EPC overrules jurisdiction of the Enlarged Board of Appeal.

IPO notes that in the T 39/93 (which is cited by the T 1063/18), a statement was made concerning the hierarchy of the Implementing Regulations and decisions of the Enlarged Board of Appeal (3.3):

*“[The] meaning of an Article of the EPC (here, Art. 114), on its true interpretation as established by a ruling of the Enlarged Board of Appeal cannot, in the Board's view, be overturned by a newly drafted Rule (here: Rule 116) of the Implementing Regulations, the effect of which is to conflict with this interpretation. This is because, according to Art. 164(2) EPC, in the case of conflict between the*

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provisions of this Convention (the EPC Article) and those of the Implementing Regulations, the provisions of this Convention shall prevail.” (emphasis added)

However, IPO notes that the G 6/95, which finally ruled about the Rule 116, did not cite the T 39/93 nor make any statement concerning whether the Enlarged Board of Appeal endorses this view.

IPO is aware that the T 39/93 is cited in the G 2/07. However, it is unclear that the assumption made in the president’s referral that the G 2/07 does not endorse the T 39/93 is correct. This becomes apparent when the whole passage 2.4. of this decision is taken into account:

*“Based on the assumptions that the approach to the interpretation of Article 53(b) EPC adopted by the boards of appeal prior to the introduction of Rule 23b(5) EPC 1973 reflected the true meaning of that Article, and that Rule 23b(5) EPC 1973 was aimed at a very narrow construction of Art. 53 (b) EPC 1973, and one which was hardly to be reconciled with the previous interpretation of that Article, the referring Board considers that Rule 23b(5) EPC 1973 is in conflict with Art. 53(b) EPC 1973, contrary to Art. 164(2) EPC. Reference is made by the referring Board to decision T39/93 (OJ EPO 1997, 134, point 2.3 of the Reasons), in which it was held that, in view of Art. 164(2) EPC, the meaning of an Article of the EPC on its true interpretation as established – in that case – by a ruling of the Enlarged Board of Appeal cannot be overturned by a newly drafted rule of the Implementing Regulations. As will be set out below, this reasoning is based on assumptions which are not endorsed by the Enlarged Board, so that a problem of conflict between Rule 26(5) EPC and Article 53(b) EPC in the sense described by the referring Board does not arise.”*

IPO is of the opinion that the Enlarged Board of Appeal has not taken a position concerning whether it follows the approach of the T 39/93 or not. Rather, it does not follow the initial assumptions that the interpretation prior to Rule 23 b (5) was the true interpretation of Art. 53 (b) EPC. Whether the approach of the T 39/93 is correct was left open.

IPO is aware that also the T 315/03 (“Harvard Mouse”) contains a statement Art 164(2):

*“The Boards also have jurisdiction to give effect to Art. 164(2) EPC to refuse enforcement of a Rule of the Convention which conflicts with an Article. But none of these powers mean that the Boards have any power, express or necessarily implied, to prevent the operation of correctly enacted legislation and, as regards the passage of legislation, the choice between Articles and Implementing Regulations is one exclusively for the legislator.”* (emphasis added)

IPO does not believe this statement (which is again an *obiter dictum*) provides efficient clarity. As a result, question 1 must be answered by using analogies to other jurisdictions and policy considerations.

IPO suggests that decisions of the Enlarged Board of Appeals—the highest decision-making body within the European juridical system—should be given the most weight.

It cannot—and should not—be that decisions of the Enlarged Board of Appeal cannot be overturned by an amendment of the European Patent Convention. That would make the Enlarged Board of Appeal a higher authority than civil law. Decision G 2/08 cited above, which has made this clear.

On the other hand, if a decision of the Enlarged Board of Appeal could be overturned by an amendment of the Implementing Regulations, this would give the Administrative Council the unfettered ability to overturn any case that it does not like. The Implementing Regulations of the European Patent Convention can be amended rather easily, and giving the Implementing Regulations higher status than decisions of the Enlarged Board of Appeal would *de facto* place the Administrative Council in a position of authority over the Enlarged Board of Appeal.

In most member states of the European Patent Convention, it is not possible to overturn decisions of high-ranking decision-making bodies by issuing legal texts that have a lower hierarchy than laws. For example, in Germany a regulation (“Verordnung”) may not overturn decisions of the Bundesgerichtshof.

As a result, decisions of the Enlarged Board of Appeal should have a higher rank than Implementing Regulations.

The situation is different for decisions of the Boards of Appeal. Because the legal framework of the European Patent Convention allows different Boards to issue inconsistent decisions, decisions of the Boards should not block Implementing Regulations. That should be a privilege only of the Enlarged Board of Appeal.

Thus question 1 should be answered as follows:

***The meaning and scope of Article 53 EPC—and subsequently any other article of the EPC—can only be clarified in the Implementing Regulations to the EPC as long as it is not a violation of an interpretation of said Article given in earlier decisions of the Enlarged Board of Appeal.***

***The meaning and scope of Article 53 EPC—and subsequently any other article of the EPC—can be clarified in the Implementing Regulations to the EPC regardless of interpretations of said Article given in earlier decisions of the Board of Appeal.***

The referral does not address which body of the European Patent Office, i.e. the Boards of Appeal or Enlarged Board of Appeal, is competent to decide whether a violation of Art 164(2) has occurred. The only decision giving a statement—albeit in an *obiter dictum*—in this regard is T 315/03, which has never been confirmed by the Enlarged Board of Appeal or another Board.

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For the reasons discussed above, IPO respectfully suggests that the Enlarged Board of Appeal should have the sole privilege to decide about violations of Art 164(2). As a consequence, Boards would refer relevant cases to it. We would welcome guidance from the Enlarged Board of Appeal in this respect.

***2. If the answer to question 1 is yes, is the exclusion from patentability of plants and animals exclusively obtained by means of an essentially biological process pursuant to Rule 28(2) EPC in conformity with Article 53(b) EPC which neither explicitly excludes nor explicitly allows said subject-matter?***

**Suggested Answer:**

***This question is obsolete since the answer to question 1 is no.***

Because the question to Answer 1 is yes and the Enlarged Board of Appeal is involved, question 2 is moot.

IPO thanks the Enlarged Board of Appeal for the opportunity to provide comments.

Yours faithfully,



Henry Hadad  
President

## APPENDIX<sup>1</sup>

### Members of the Board of Directors Intellectual Property Owners Association

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<sup>1</sup>IPO procedures require approval of positions in briefs by a two-thirds majority of directors present and voting.

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